

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michel Kubacki
Title: METHODS, RACK AND
DEVICE FOR PREPARING
SAMPLES FOR ANALYSIS
Appl. No.: 10/544,158
International Filing Date: 2/2/2004
371(c) Date: 10/14/2005
Examiner: Timothy Lewis Maust
Art Unit: 3751
Confirmation Number: 8425

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully renew their request for reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent which issued on November 3, 2009 as U.S. Patent No. 7,610,941. The USPTO indicated in the letter mailed September 28, 2009 (copy attached as Exhibit A), that a decision on the Applicants' initial request was dismissed as premature.

The Patent Office determined that the patent was entitled to 656 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008).

The court determined that, under the correct interpretation of the PTA statute, periods of “overlap” are limited to “periods of time . . . [that] occur on the same day.” *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays “occur on the same day.” *Id.*

Applicants have recalculated PTA for the captioned patent under the court’s interpretation of the PTA statute, and have determined that the patent is entitled to 1055 days PTA, as shown on the attached sheet (Exhibit B), which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

There were no circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 1055 days

(b) Total Applicant delay: 0 days

Final PTA Determination: 1055 days

Applicants therefore respectfully request that the patent be accorded 1055 days PTA.

The patent is not subject to a terminal disclaimer.

Because this is a renewed request, Applicants do not believe that any fee is due, the fee having been paid with the Applicants’ original request on July 16, 2009. However, if a fee is due, and should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Applicants request further that a decision on this request be deferred or delayed until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date December 21, 2009

By  _____

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Callie M. Bell
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EXHIBIT - A
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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OFFICE OF PETITIONS

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In re Application of :
Michel Kubacki :
Application No. 10/544158 : ON REQUEST FOR
Filing or 371(c) Date: 10/14/2005 : RECONSIDERATION OF
Attorney Docket No. : PATENT TERM ADJUSTMENT
052546-0480 :

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705, filed July 16, 2009. Applicant submits that the correct patent term adjustment to be indicated on the patent is 1048 days, not 656 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent. The request is properly treated under 37 CFR 1.705(b).

Patentees also request that a decision on this request for reconsideration of patent term adjustment be deferred or delayed until after a final decision has been rendered in Wyeth v. Dudas. There is no specific regulatory provision for requesting that a petition under 37 CFR 1.705(d) be held in abeyance. Accordingly, the request to hold in abeyance a decision on the merits of the instant application for patent term adjustment is **DISMISSED**.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected

EXHIBIT - A

Application No. 10/544158

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issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

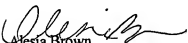
Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

The Office acknowledges submission of the required \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b). As the fee is a prerequisite prior to treatment on the merits of any request for reconsideration of patent term adjustment, the request for refund is DISMISSED.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Attorney Derek Woods at (571) 272-3232.


Alecia Brown
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

CLOSE WINDOW

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EXHIBIT B

Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 052546-0480

Application Number: 10/544158

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Priority Date	02/03/2003	-912		
Edit Delete	International Filing Date	02/02/2004	-548		
	PCT National Stage Commencement Date	08/03/2005	0		
Edit Delete	National Stage Entry (All 371(c) Requirements Met)	10/14/2005	72		
	14 month From Application date	12/14/2006	498		
	3 Year Period Starts	08/03/2008	1,096		
Edit Delete	Restriction Requirement	09/30/2008	1,154	(656)	
Edit Delete	Restriction Requirement Response Received at PTO	10/30/2008	1,184		
Edit Delete	Non-Final Office Action	01/28/2009	1,274		
Edit Delete	Non-Final Office Action Resp. Rcv'd at PTO	04/06/2009	1,342		
Edit Delete	Notice of Allowance	04/17/2009	1,353		
Edit Delete	Issue Fee Paid	07/16/2009	1,443		
Edit Delete	Patent Grant Date	11/03/2009	1,553	(457) 1055	
	Totals:			1,055	0
	PTA:			1,055	

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